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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/890,739	01/16/2002	Gaute Munch	2388-798	7866

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EXAMINER	
SAGER, MARK ALAN	
ART UNIT	**PAPER NUMBER**
3714	

DATE MAILED: 08/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/890,739	MUNCH ET AL.	
	Examiner	Art Unit	
	M. A. Sager	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 April 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-12,14 and 25-33* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-12,14 and 25-33* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the microprocessor, the display, the coupling means and the communication means are 'integrated in a single self-contained element' lacks antecedent basis, as claimed. This is neither an enablement nor new matter holding, but rather is an objection of the disclosure due to lacking antecedent basis within the specification.

Claim Interpretation

Although Applicants can be their own lexicographer, no clarity of definition of 'integrated in a single self-contained element' was provided to limit the form of invention to a fabrication of the parts from a single piece so as to form a single self-contained element and thus includes constituent parts [processor, display, coupling means and communication means] being combined as to constitute a unitary whole and thus is inclusive of other means for maintaining the parts fixed together as a single self-contained unit within the broadest interpretation thereto.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claim1, 3-12, 14-23, 25-33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Haugerud (4712184) in view of Chainani (5724074). This holding is maintained from prior Office action for cited claims, as amended, which is re-iterated in part herein, but which is fully incorporated herein. Response to Applicants' remark is provided below and incorporated herein. Haugerud discloses a microprocessor controlled toy building element (1:8-12, 1:31-2:5, 2:39-12:5, fig. 1-14), comprising a microprocessor (ref. 1) which can execute instructions of a program stored in a memory (C64 or Apple II), memory comprising subprograms activated by subprogram calls (abstract), coupling means inter-connectable with building elements which can be moved by activation means, the activation means being controllable in response to the instructions (abstract, 3:4-4:14, 4:59-5:42, 7:44-12:5), a communication means is arranged to transmit the list of subprogram calls to a second toy building element for programming of it (1:43-63), wherein the microprocessor and the communication means are integrated in a single self -contained element that provides a facility for transmitting a program and a programming facility that are integrated portions of the toy element wherein the program is run (fig. 1) at least due to breadth of language not being so limiting to preclude each component as a self-contained element or to require each listed component in 'only' a single self-contained element. Further, Haugerud lacks a 'display that that can show a plurality of icons which can be activated, one-by-one to create a program' comprising a list of said subprogram calls, for programming the microprocessor and controlling the toy building element by means of the activation means. For

clarity, Haugerud lacks the display of a plurality of icons since Haugerud's plurality of input buttons are [visual] elements which can be activated one by one to create a program comprising a list of subprogram calls for programming the microprocessor and controlling the toy building element by means of the activation means (fig. 1-14, ref 1). However, Chainani (figs. 1-9B) discloses a home computer in connection with a programmable toy and a display that that can show a plurality of icons which can be activated, one-by-one to create a program' comprising a list of said subprogram calls, for programming the microprocessor and controlling the toy building element by means of the activation means (fig. 7) in order to allow children (or those of low programming skill) to program a toy microprocessor more easily due in part to use of visual 'icons' for indicating subprogram calls of functional actions the toy may perform (abstract, 2:27-4:19). The references are analogous since both refer to controlling a programmable toy via a microprocessor. Also, Chainani is relevant prior art at least due to either the reference being within the applicants' field of endeavor [generation, display and communication of program in toy module] or being reasonably pertinent to the particular problem with which the applicant was concerned [generation of program from a list of icons depicting subprogram actions the toy can perform]. Therefore, it would have been obvious to an artisan at a time prior to the invention to add a display that can show a plurality of icons which can be activated, one-by-one to create a program' comprising a list of said subprogram calls, for programming the microprocessor and controlling the toy building element by means of the activation means as suggested/taught by Chainani to Haugerud's computer controllable toy in order to allow children (or those of low computer skill) to program a toy microprocessor more easily due in part to use of visual 'icons' for indicating subprogram calls of functional actions the toy may perform (abstract, 2:27-4:19).

Referring to claim 3, Haugerud in view of Chainani further include instructions corresponding to one icon, implement a rule by controlling the activation means in response to signals from sensors connected to the toy building element.

Referring to claims 4-5 and 7-9, Haugerud in view of Chainani (5:40-67) further include a receiver for wireless reception of instructions and the toy comprises communication means for transferring information via an elongated light guide through which visible light may be transmitted in its longitudinal direction, the light guide being adapted to allow part of the light transmitted to escape through its sides.

Referring to claim 6, Haugerud discloses use of a keyboard for manual entering of instructions (ref. 1).

Referring to claim 10-11, Haugerud (fig. 1-14, refs. 1-12, esp. 1, 4) includes first and second microprocessor controlled toy building elements in view of Chainani (figs. 1-9B) where the second microprocessor controlled toy building element (Chainani, fig. 1-4, ref. 24, 50, 52) comprises a memory with subprograms which can be activated individually by receiving subprogram calls from the first toy building element (Chainani, ref. 10, 12, 14, 22, 23, 25) and the first microprocessor controlled toy building element further comprises operating means for making a program (sic) and that the second microprocessor controlled toy building element comprises operating means for activating just one of several programs (figs. 1-4, refs. 50, 52, 54, 56, 58, 60, 62, 64, 41, 82, 84).

Claims 12, 14-23, 25-33 correspond in scope to a toy building element set forth above in claims 1, 3-11 discussed above; therefore, the discussion above is incorporated herein.

4. Claim 1, 3-12, 14-23, 25-33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Haugerud (4712184) in view of Chainani (5724074) and either Choi (6083104) or Ho (5259626). Where the microprocessor, the display, the coupling means and the communication means are integrated in [only] a single self -contained element that provides a facility for transmitting a program and a programming facility that are integrated portions of the toy element wherein the program is run (which such language includes but which is not presently so limiting to this form), discussion above regarding what Haugerud in view of Chainani taken at a time prior to the invention suggests to an artisan is incorporated herein. Haugerud in view of Chainani lacks the form of invention whereby the microprocessor, the display, the coupling means and the communication means are integrated in only (not presently so limiting) a single self -contained element that provides a facility for transmitting a program and a programming facility that are integrated portions of the toy element wherein the program is run. However, integration of components to form a self-contained element. In re Larson et all, 144 USPQ 347. For instance, Choi (figs. 16-8A, 9A-11,) or Ho (fig 1-4, esp. 2 & 4) each discloses programmable toy element comprising a microprocessor, display, coupling means and communication means are integrated in only a single self-contained element that provides a facility for transmitting a program and programming facility that are integrated portions of the toy element wherein the program is run. Also, Choi or Ho is each relevant prior art at least due to either the reference being within the applicants' field of endeavor [generation, display and communication of program from component elements integrated in a single self-contained element] or being reasonably pertinent to the particular problem with which the applicant was concerned [generation of program from a list of icons depicting subprogram actions the toy can

perform]. Within consideration of it being known [official notice] for technology to miniaturize electronics including microprocessor (note PDAs, hand held games, credit card size calculators, as evidence only), forming of single self-contained element was well within skill of artisan and is customary or obvious to an artisan in order to further reduce size of a device for ease of use/transport and storage (as evidence only, such as by separate game machine, display and joystick controller found in Atari or Nintendo game platform being reduced in scale to unitary self-contained game machine such as Game Boy). Therefore, it would have been obvious to an artisan at a time prior to the invention to add a single self-contained element as known in the art and/or suggested/taught by either Choi or Ho to Haugerud's computer controllable toy in view of Chainani so as to provide a single unit for ease use/transport and storage thereby precluding multiple separate units for storage or use.

Response to Arguments

5. Applicant's arguments filed 4/28/04 have been fully considered but they are not persuasive. Applicant remarks in part that the language, particularly regarding the integration into "a single self-contained element" defines over the cited art'; however, the examiner respectfully disagrees at least since the breadth of claim language is not as limiting as Applicant asserts in that it fails to preclude each component being a single self-contained element or that the toy element as a whole is single self-contained element. Thus, Haugerud's computer controllable toy in view of Chainani's method and system for graphically programming toys via a graphic interface is a 'single self-contained element'.

6. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection. Criticality of [only] a single self-contained element not established within disclosure or record. Note discussion above with respect to disclosure.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hida discloses construction device cited by Haugerud as toy building elements.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. A. Sager whose telephone number is 703-308-0785. The examiner can normally be reached on T-F, 0700-1700 hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, Jessica Harrison can be reached on 703-308-2217. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M. A. Sager
Primary Examiner
Art Unit 3714

MAS